

REMARKS

This is intended as a full and complete response to the Office Action dated February 15, 2008, having a shortened statutory period for response set to expire on May 15, 2008. Please reconsider the claims pending in the application for reasons discussed below.

Claims 7, 9-15, 20-22 and 24-26 are pending in the application. Claims 7 and 9-15 remain pending following entry of this response. Claims 7, 12 and 14 have been amended. Claims 20-22 and 24-26 have been cancelled. Applicants submit that the amendments do not introduce new matter.

Further, Applicants are not conceding in this application that those amended (or canceled) claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the claimed subject matter. Applicants respectfully reserve the right to pursue these (pre-amended or canceled claims) and other claims in one or more continuations and/or divisional patent applications.

Interview Summary

On May 1, 2008, a telephonic interview was held between Gero G. McClellan, attorney of record, Sarah Koniewicz, technical advisor, the assistant Examiner and the Supervisory Examiner. The parties discussed the cited references including *Bays*. Claim 7 was discussed. The parties also discussed possible amendments to claim 7. The proposed amendments are reflected in this response.

During the interview, Applicants suggested that *Bays* did not teach "providing a set of one or more configuration tools allowing a user to define an annotation structure containing one or more annotation fields and associate the annotation structure with at least one of the annotatable data objects, wherein the configuration tools further allow a user to define roles and associate annotation structures with combinations of roles and annotatable data objects." No agreement could be reached at the time of the interview, but the Examiners agreed that the proposed amendments discussed would clarify the claimed subject matter.

Claim Objections

Claims 9 and 10 are objected to because of the following informalities: Claim 9 improperly depends on claim 8, which has been canceled. Similar informality exists in claim 10.

Claim 12, line 2, the Examiner suggests using "a user" or "users" instead of "a users". Appropriate correction is required.

Applicants have made the appropriate corrections, and withdrawal of the objection is respectfully requested.

Claim Rejections - 35 U.S.C. § 101

Claims 20-22 and 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicants have cancelled claims 20-22 and 24-26 without prejudice, therefore the rejection is obviated.

Double Patenting Rejection

Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 11/325,371.

Applicants acknowledge the double patenting rejection and respectfully request that the rejection be held in abeyance because (i) no claim in the present application is currently allowable and (ii) the application on which the rejection is made has not issued. Because it is possible that no claims will issue, or that the claims of the present application will be amended in such a way to overcome the Examiner's concerns regarding double patenting, Applicants defer responding until the present rejection ripens into an actual double patenting rejection

Claim Rejections - 35 U.S.C. § 102

Claims 7, 9-15, 20-22, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by *Bays et al.* (US Patent 6,519,603, hereinafter *Bays*).

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Bays* does not disclose "each and every element as set forth in the claim". For example, *Bays* does not disclose a method for exchanging information between entities on a network that includes "identifying a plurality of annotatable heterogeneous data objects, each manipulated by a corresponding one of a plurality of applications on the network, wherein each of the plurality of applications provides an indexing mechanism for indexing data objects associated with a respective application."

Thus, as claimed, different applications may each include a different indexing mechanism used to index data object manipulated by a given applications, e.g., an indexing mechanism for images or video files is likely to differ from an indexing mechanism for text documents or database tables. Further, each indexing mechanism is likely to use different metadata elements from a given data object to map the object to a position in the index (and vice versa). Accordingly, as claimed, the configuration tool allows "a user to define an annotation structure containing one or more annotation fields for annotations created for a respective application ... wherein one or more of the annotation fields store metadata used to index an annotation according to the indexing mechanism associated with the respective application."

In contrast, *Bays*, does not teach different indexing mechanisms for heterogeneous data sources. Instead, *Bays* indexes annotations by only one method, for example, by indexing them into one database regardless of the annotations' data source or type of object being stored in the database. Thus, *Bays* treats annotations the same regardless of the particular data object being annotated, whereas the present

claims recite a limitation of different indexing mechanisms for annotations from different types of data sources.

Furthermore, *Bays* does not teach a set of one or more configuration tools configured to "a user to define an annotation structure containing one or more annotation fields for annotations created for a respective application ... wherein one or more of the annotation fields store metadata used to index an annotation according to the indexing mechanism associated with the respective application," as recited by claim 7. The Examiner cites to *Bays*, column 9, lines 43-49 to teach associating the annotation structure with at least one of the annotatable data objects. In light of the clarifying claim amendments, Applicants submit that *Bays* does not teach annotation structures containing annotation fields which include one or more annotation fields for annotations created for a respective application wherein one or more of the annotation fields store metadata used to index an annotation according to the indexing mechanism associated with the respective application.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claim 26 is rejected under 35 U.S.C. 103(a) as being obvious over *Bays* as applied to claim 25 above, and further in view of *Rubin et al.* (US Patent Publication 2002/0099552, hereinafter *Rubin*).

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Applicants have cancelled claim 26 without prejudice, therefore the rejection is moot.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)